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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,571	04/23/2002	Yoshiki Nakagawa	010903	1695

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EXAMINER

ZALUKAEVA, TATYANA

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 12/31/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/889,571

Applicant(s)

NAKAGAWA ET AL.

Examiner

Tatyana Zalukaeva

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-51 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-18 drawn to a method of making a polymer and a polymer obtained by this method.

Group II, claim(s) 19-20, drawn to a crosslinked polymer.

Group III, claim(s) 21-25, drawn to a curable composition.

Group IV, claim(s) 26-44, drawn to yet another method of making a polymer and a polymer obtained by this method.

Group V, claim(s) 45, 46, drawn to a crosslinked vinyl polymer.

Group VI, claim(s) 47-51, drawn to a curable composition.

2. The inventions listed as Groups I, II, III, IV, V and VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they

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lack the same or corresponding special technical features for the following reasons:
when the polymer obtained by the methods of group I or IV is crosslinked the reaction between chains and/or between functional groups of polymer with functional groups of a crosslinking agents results in a formation of a new product that has different functionalities, and therefore, the initial product loses its chemical identity, therefore the specific technical feature linking two inventions together, namely the polymer as produced in claims of groups I or IV ceases to exist.

When the polymer obtained by the processes of Groups I or IV becomes a part of the curable composition, it involves another compound, which reacts with the functional groups of initially produced polymer, thus the functionality of a polymer changes. So does the very chemical identity of a polymer.

With regard to Groups I and II there are disclosed two materially different methods of making polymers, and since the polymers claimed are produced by these particular methods, the polymers should be different, and therefore specific linking technical feature connecting both polymers is missing.

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

- A **functional group** of compound (I), as per claims 1 and 26, which are exemplified by species of claims 2-4 and 27, 28
- **A compound (I)**, as per claim 1, which is exemplified by species of claims 5 - 7;
- **An initiator of claim 11**;
- **A compound (B)** of a curable composition as per claims 21 and 47, which are exemplified in any of claims 22-25; 48-51
- **A compound (II)**, as per claim 26, species of which are exemplified in claims 30, 31;

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: 1, 11, 21, 26, 47.

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4. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: the above species, which represent terminal functional groups are groups of different organic classes having different functional groups, and even different heteroatoms, thus producing polymers having different functionalities, different properties and functions and being so different loose the specific common technical feature.

Where specific species are not identified in the claims, Applicant should elect a specific specie from the Specification. An alternative method of election is to identify an Example which collectively exemplifies the elected species.

5. Due to a complexity of election/restriction requirement no telephone call was made to request an oral election to the above restriction requirement. Applicants cooperation is appreciated.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (703)308-8819. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

TATYANA ZALUKAEVA
PATENT EXAMINER



December 16, 2002

Tatyana Zalukaeva
Primary Examiner
Art Unit 1713